



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,987	11/30/2000	Magnus Hollstrom	47253-00014	2119

7590 06/28/2004  
Richard J. Moura, Esq.  
Jenkins and Gilchrist, P.C.  
3200 Fountain Place  
1445 Ross Ave.  
Dallas, TX 75202

EXAMINER

NGUYEN, SIMON

ART UNIT	PAPER NUMBER
----------	--------------

2685

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/726,987

Applicant(s)

HOLLSTROM ET AL.

Examiner

SIMON D NGUYEN

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9, 12-15, 18-19, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saarela et al. (6,366,785) in view of Segal et al. (6,167,251).

Regarding claim 1, Saarela discloses a method of playing back audio signals in a first communications device, transmitting the audio signals to a second communication device, and playing back the audio signals in the second communication device (column 3 line 18 to column 4 line 50). However, Saarela does not specifically disclose playing back audio signals in the first communication device.

Segal discloses a communication system for downloading music or other audio information (fig.29) in which a music source (38n) is playing back by a server (30), wherein the music is downloaded by a wireless phone and played back by a user (column 30 line 15-37). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have Saarela, modified by Segal to download audio signal in real time in order to be played back as a time of interest.

Regarding claims 12-13, these claims are rejected for the same reason as set forth in claim 1.

Regarding claim 18, this claim is rejected for the same reason as set forth in claim 1, wherein an accessory device (document outbox) plays back audio signals (recorded voice signals) and transmits to other telephone (figs. 1, 2, column 3 lines 40-67).

Regarding claims 2-3, 14, Saarela further discloses the first communication device is a mobile telephone (cellular) and the second communication device is a telephone (fig. 1).

Regarding claim 4, 9, Saarela discloses the step of establishing a connection through the network between the first and second device and transmitting the audio signals to the second device (fig. 1). However, Saarela does not specifically disclose the steps of establishing a conversation prior to transmitting the audio signals.

Segal discloses the steps of establishing a call conversation between the server and the mobile phone (second device) (column 12 lines 13-25), and transmitting audio signals to the second device and wherein the audio signals are transmitted from the network (base station) to the communication device (fig. 29, column 30 lines 15-37). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have Saarela, modified by Segal to combine audio signals and voice signals in one channel in order to transmit voice and audio signals simultaneously.

Regarding claims 5-7, the modified Saarela system, Saarela discloses a voice channel (column 1 lines 58-60) and a data channel (column 2 lines 4-9), and Segal discloses voice mixed with audio signals (column 16 lines 1-8, column 32 lines 24-30).

Art Unit: 2685

Regarding claim 8, Saarela discloses the voice signal transmitted by a voice channel (column 3 lines 55-57) and the audio signal by a data channel (signaling channel)(column 3 lines 58-60, column 4 lines 31-31).

Regarding claim 15, Saarela further discloses the communication device is adapted for use in a public network (column 3 lines 21-22).

Regarding claim 19, Saarela discloses the public network comprises a GSM network (column 3 line 51).

Regarding claims 21-22, Saarela discloses the public network is a GSM network (column 2 line 10) and a digital network (column 4 lines 12-14). However, Saarela does not specifically disclose the public network as an enhance data rates of GSM (EDGE) and a WCDMA. It should be noted that the GSM of Saarela can be modified to become an EDGE network and the GSM is either a CDMA or a Wide CDMA. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to convert the Saarela system into the EDGE and WCDMA to handle different data rates of digital audio signals in order to improve the system performance.

3. Claims 10-11 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saarela et al. (6,366,785) in view of Segal et al. (6,167,251) as applied to claim 9, and further in view of Abecassis et al. (6,192,340).

Regarding claims 10-11, Saarela discloses the audio signals are digitized (column 3 lines 26-27), Segal discloses the audio signals used in MP3. However, the

Art Unit: 2685

modified Saarela system does not specifically disclose that the audio signals are compressed.

Abecassis discloses a playback audio communication system in which audio signal is digitized and compressed in a MP3 format (column 5 line 40, column 7 line 32). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have modified Saarela system, modified by Abecassis in order to store double or triple audio data than in the same uncompressed storage area.

Regarding claims 25-28, the modified Saarela system does not specifically disclose the first and second devices simultaneously play the same audio signal.

Abecassis discloses a system for downloading music via MP3, in which an audio item is retrieved at the time of its playing and retrieved and played in a real-time manner (column 11 lines 25-30, 58-61, column 14 lines 60-62, column 28 lines 1-13). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have modified Saarela system, modified by Abecassis in order to retrieve audio items consistent with the user's preferences and selection criteria.

4. Claims 16-17, 20, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saarela et al. (6,366,785) in view of Segal, and further in view of Schuster et al. (6,446,127).

Regarding claims 16, 20, 23-24, the modified Saarela system does not specifically disclose the communication device is adapted to use in a wireless short range, as bluetooth, infrared, and in a GPRS network.

Schuster, in the same kind of invention, discloses the communication device is adapted to use in a wireless short range as a Bluetooth, and an infrared (column 7 lines 33-43), and being used in a packet network (column 14 lines 5-36) as a GPRS. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have the modified Saarela system, modified by Schuster to implement a short-range transceiver with a packet network in order to improve the system performance without significantly increasing cost of the telephone.

Regarding claim 17, Saarela discloses the audio signal (recorded message) integrated in the communication device (fig.1, column 3 lines 38-60).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Nguyen whose telephone number is (703) 308-1116. The examiner can normally be reached on Monday-Friday from 7:00 AM to 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban, can be reached on (703) 305-4385.

Art Unit: 2685

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231


Or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Hand-delivered response should be brought to Crystal Park II,  
2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Simon Nguyen

June 17, 2004

A handwritten signature in cursive script that reads "Simon Nguyen".